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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/701,634      | 12/01/2000  | Makoto Miyazawa      | Q61929              | 8039             |

7590 03/26/2002

Sughrue Mion Zinn Macpeak & Seas  
2100 Pennsylvania Avenue N W  
Washington, DC 20037-3213

EXAMINER

MARKHAM, WESLEY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 03/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-11

|                        |                               |                                  |  |
|------------------------|-------------------------------|----------------------------------|--|
| <b>Advisory Action</b> | Application No.<br>09/701,634 | Applicant(s)<br>MIYAZAWA, MAKOTO |  |
|                        | Examiner<br>Wesley D Markham  | Art Unit<br>1762                 |  |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-10.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION / ADVISORY ACTION**

Acknowledgement is made of applicant's proposed amendment B, filed as paper #9 on March 4, 2002, in which the applicant proposed to cancel Claims 6 – 10, amend Claims 1, 3, and 5, and add Claims 11 – 12. However, this amendment will not be entered as it raises new issues that would require further consideration and/or searching. For example, proposed amended independent Claim 1 would now require, after the marking step, at least one step selected from the group consisting of a polishing step, a dyeing step, a hard coat formation step, and an anti-reflection coating formation step, after which the edging mark remains on the spectacle lens. In addition, proposed new Claim 11 would require that the edging line is about 1 mm larger than the inner peripheral edge of an opening of the spectacle frame. These limitations have not previously been present in the claims and therefore would require further consideration and/or searching.

### ***Response to Arguments***

1. Acknowledgement is made of applicant's arguments filed on March 4, 2002.

However, these arguments are not persuasive because they are drawn to claim limitations that were proposed by the applicant in amendment B, filed on March 4, 2002, which has not been entered.

***Drawings***

2. The corrected or substitute drawings (i.e., the one sheet of formal drawings depicting Figure 5 labeled as "PRIOR ART") were received on March 4, 2002. These drawings are acceptable.

***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.
4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
5. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham  
Examiner  
Art Unit 1762

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WDM

March 25, 2002

WDM

A handwritten signature in black ink, appearing to be 'Shrive P. Beck', with a long horizontal line extending to the right.

**SHRIVE P. BECK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**